

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): R. H. Utley
Case: 3
Serial No.: 10/675,716
Filing Date: September 30, 2003
Group: 2181
Examiner: Richard B. Franklin

Title: Processor with Input Data Block Discard Mechanism
for Use in an Oversubscription Condition

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The remarks below are submitted in response to the Notification of Non-Compliant Appeal Brief dated March 19, 2007, in the above-identified application. The Appeal Brief at issue was filed January 2, 2007.

For the reasons identified herein, Applicant (hereinafter "Appellant") believes that the Notification of Non-Compliant Appeal Brief is improper and should be withdrawn, and that the January 2, 2007 Appeal Brief is in fact compliant with all relevant statutes and regulations.

Notwithstanding the traversal, an Amended Appeal Brief is submitted herewith.

REMARKS

In the Notification of Non-Compliant Appeal Brief, the Examiner objects to the January 2, 2007 Appeal Brief as failing to contain a concise explanation of each dependent claim that is argued separately.

The relevant regulation governing the summary of claimed subject matter in an Appeal Brief is 37 C.F.R. §41.37(c)(1)(v), which provides as follows with emphasis supplied:

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

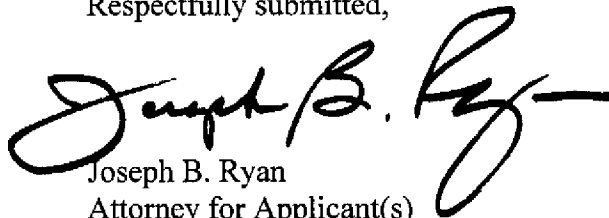
The Examiner in objecting to the summary with regard to dependent claims 8-10, 13 and 14 apparently relies on the second sentence of 37 C.F.R. §41.37(c)(1)(v), containing the underlined portion above. However, it is clear that this sentence as applied to separately-argued dependent claims only requires that every means plus function and step plus function be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. Separately-argued dependent claims 8-10, 13 and 14 do not include any means plus function or step plus function recitations. Accordingly, Appellant submits that the summary provided in the January 2, 2007 Appeal Brief is proper and fully compliant with 37 C.F.R. §41.37(c)(1)(v).

The Notification of Non-Compliant Appeal Brief is therefore believed to have been issued in error, and should be withdrawn.

Notwithstanding the traversal, Appellant submits herewith an Amended Appeal Brief, which refers to the specification and drawings with regard to separately-argued dependent claims 8-10, 13 and 14.

Additionally, Appellant notes that the Examiner has placed the Information Disclosure Statement filed January 2, 2007 in the application file but has not considered the information referred to therein. Appellant has placed the references contained therein into the Evidence Appendix and requests that they be considered under MPEP §§ 609.05(c) ("To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant.") and 1205.02 ("If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief."), as well as 37 CFR 41.37(c)(1).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan", with a long horizontal flourish extending to the right.

Date: April 19, 2007

Joseph B. Ryan
Attorney for Applicant(s)
Reg. No. 37,922
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7517